

Remarks

The following remarks are submitted to address the issues raised in the Office Action mailed July 29, 2003.

Claims 1-7 and 11-62 are pending in the present application.

Claims 2-7, 11, 13-17, 19-40, 46-48, 52-55, and 57-60 were withdrawn from consideration by the Examiner after Applicants elected the compound of Example 8.

Claims 1, 41-45, 49-51, 56, 61, and 62 stand rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement.

Claims 1, 41-45, 49, 50, 51, and 56 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particular point out and distinctly claim the subject matter which the Applicants regarded as the invention.

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 5,795,907 to Kalindjian et al. and by the Tsukita, Sivanandaiah, and Pirkle abstracts.

Claims 1 and 41 stand rejected under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 5,153,226 to Chucholowski et al.

Claims 1, 41-45, 49-51, and 56 stand rejected under 35 U.S.C. § 103(a) as being obvious over Chucholowski.

Claims 12 and 18 were considered to be allowable by the Examiner but were objected to as being dependent on a rejected claim.

No new matter has been added. The foregoing rejections and other items in the Office Action are addressed in the following paragraphs. Consideration of the pending claims is respectfully requested in view of the following comments.

Claim Amendments

Claim 1 has been amended to include Markush type language, to clarify the description of G_1 , and to include the limitation that at least one group of the formula $-L-C_1-C_6\text{-alkyl-NR}_{14}R_{15}$ is substituted onto the phenyl groups of R_4 . Support for the limitation of “at least one group of the formula $-L-C_1-C_6\text{-alkyl-NR}_{14}R_{15}$ ” can be found in species described in Examples 1-30 where each compound comprises an aryl ring substituted by at least one group of the formula $-L-C_1-C_6\text{-alkyl-NR}_{14}R_{15}$. Further support for this limitation can be found on page 3, lines 16-17, stating that “[t]his invention provides certain substituted carboxamide compounds, wherein the amide moiety is comprised of at least one lipophilic group. Claim 1 has also been amended to clarify the description of R_7 and R_8 , and R_{14} and R_{15} .

Claim 56 has been amended to correct a typographical error.

Claim 61 has been amended to include Markush type language and to amend the scope of groups R_1 , R_3 , and R_5 . Support for the amendments to R_1 , R_3 , and R_5 can be found in the originally filed claim 1 and in the specification. Claim 61 has also been amended to clarify the description of R_7 and R_8 , and R_{14} and R_{15} .

Claim 62 has been amended to include Markush type language and to clarify the description of R_{14} and R_{15} .

Withdrawn Claims

In the Office Action mailed July 29, 2003, the Examiner stated that Applicants' non-heterocyclic fluorenyl containing urethanes not further ortho-fused, sulfur, nitro, or silicon substituted were examined. As a result, the Examiner withdrew claims 2-7, 11, 13-17, 19-40, 46-48, 52-55, and 57-60 from consideration.

Applicants respectfully request that the Examiner reinstate claim 20 that recites the species described in Example 10. This species is a non-heterocyclic fluorenyl containing

urethanes not further ortho-fused, sulfur, nitro, or silicon substituted, and therefore falls within the scope of the art examined by the Examiner.

Claims 1, 41-45, 49-51, 56, 61, and 62 - 35 U.S.C. § 112, first paragraph

The rejection of claims 1, 41-45, 49, 50, 51, 56, 61 and 62 under 35 U.S.C. § 112, first paragraph, for lack of enablement is respectfully traversed.

Applicants have amended claims 1, 61, and 62 to include Markush type language. Claims 41-45, 49, 50, 51, and 56 ultimately depend from claim 1.

Claims 1, 41-45, 49, 50, 51, and 56 - 35 U.S.C. § 112, second paragraph

The rejection of claims 1, 41-45, 49, 50, 51, and 56 under 35 U.S.C. § 112, second paragraph, as being indefinite is respectfully traversed.

Applicants have amended G_1 in claim 1 to recite " G_1 is $(CH_2)_k$, where k is 0 to 3."

Claims 1 - 35 U.S.C. § 102(b)

The rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 5,795,907 to Kalindjian et al. and by the Tsukita, Sivanandaiah, and Pirkle abstracts is respectfully traversed.

Applicants have amended claim 1 to include the limitation that at least one group of the formula $-L-C_1-C_6\text{-alkyl-NR}_{14}R_{15}$ is substituted onto the phenyl groups of R_4 .

Neither Kalindjian nor the Tsukita, Sivanandaiah, Pirkle abstracts disclose a compound having a group of the formula $-L-C_1-C_6\text{-alkyl-NR}_{14}R_{15}$ substituted onto a phenyl group at the same relative position as R_4 in claim 1.

Claims 1 and 41 - 35 U.S.C. § 102(b)

The rejection of claims 1 and 41 under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 5,153,226 to Chucholowski et al. is respectfully traversed.

Applicants have amended claim 1 to include the limitation that at least one group of the formula -L-C₁-C₆-alkyl-NR₁₄R₁₅ is substituted onto the phenyl groups of R₄.

Chucholowski does not disclose a compound having a group of the formula -L-C₁-C₆-alkyl-NR₁₄R₁₅ substituted onto a phenyl group at the same relative position as R₄ in claim 1.

Claims 1, 41-45, 49-51, and 56 - 35 U.S.C. § 103(a)

The rejection of claims 1, 41-45, 49-51, and 56 under 35 U.S.C. § 103(a) as being obvious over Chucholowski is respectfully traversed.

Applicants have amended claim 1 to include the limitation that at least one group of the formula -L-C₁-C₆-alkyl-NR₁₄R₁₅ is substituted onto the phenyl groups of R₄.

Chucholowski does not disclose, teach, or suggest preparing a compound having a group of the formula -L-C₁-C₆-alkyl-NR₁₄R₁₅ substituted onto a phenyl group at the same relative position as R₄ in claim 1.

Claims 12 and 18 - Objection

Claims 12 and 18 were considered to be allowable by the Examiner but were objected to as being dependent on a rejected claim. Applicants respectfully traverse the objection to claims 12 and 18.

Claims 12 and 18 depend from claim 62 and ultimately depend from claim 61. As described above, Applicants have traversed each and every rejection of claim 61 and 62.

Fees

A two month extension fee is included with this Response as this Response is filed prior to end of the five month statutory period for reply on December 29, 2003.

Conclusion

In conclusion, Applicants request entry of the Amendments, consideration of the Remarks, and passage of the application to issuance.

Respectfully submitted,

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